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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,179	02/05/2001	John Michael Dunn	2940.2.1	2501
21552	7590	04/28/2006	EXAMINER	
			PATEL, JAGDISH	
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			3624	

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DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/777,179	DUNN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAGDISH PATEL	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 January 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 16-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 16-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/29/01</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

1. This communication is in response to the communication from the applicant regarding the restriction requirement dated 1/30/06. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

### ***Election/Restrictions***

2. Claims 1-15 have been cancelled. Claims 16-34 have been elected by the applicant and are currently pending.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 31-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 31-34 merely recite elements of an apparatus or a system without showing any functionality and therefore is rendered inoperative lacking any utility. The comparison module, the rate filter and the commission filter are software programs connected to the database and the input (means). However, such an apparatus is not functional because no element is recited which

would impart functionality to the apparatus and therefore the claimed invention as whole lack any utility.

Under the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility a claimed invention must satisfy the requirement that it be directed to a "practical application" which is to mean "the claimed invention physically transforms an article or physical object to a different state or thing, or ... the claimed invention otherwise produces a useful, concrete, and tangible result".

Based on the foregoing analysis (see utility requirement) the claimed invention fails to recite an apparatus which produces a useful, concrete, and tangible result since it lacks utility. Even assuming that the apparatus claim recites a processor to realize the functionality stated in the claim, merely filtering the rate matrix for commissions that meet certain criteria fails to achieve the threshold requirement of useful, concrete, and tangible result.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 31-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite due to the following reasons:

Independent claim recites "an input" as an element of the apparatus, this is improper because input is a process or act performed by an input means.

It is unclear how the borrower data can be compared against the loan products! On can only compare one (set of) data against another (set of) data. The claim must defined the term “loan products” to resolve this defect.

The limitation “comparing the list to investor” is vague and unclear. This is interpreted to read “comparing the list to the borrower data”.

### ***Claim Rejections - 35 USC § 102***

4. A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 16-21 and 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by US PGPUB 2004/0002915, to McDonald et al. (hereafter referred to as McDonald).

Per claims 16 McDonald teaches a method for originating a loan for a borrower, the

method comprising:

prompting Realtor concerning loan origination for a borrower;

(para [0032], refer to process performed by the originator)

qualifying the borrower for at least one loan program;

(para [0032] and Figure, 3 which is a flow chart depicting a customized process for a real estate loan broker/agents (originator “RE”)

obtaining list qualified loan programs, each qualified loan program including a rate and a commission;

presenting at least one qualified loan program the borrower;

applying on behalf of the borrower for one qualified loan program to procure a loan application; and

monitoring status of the loan application and commission pipeline.

(para [0032] and Figure, 3 which is a flow chart depicting a customized process for a real estate loan broker/agents (originator “RE”).

The features recited in claims 17, 18, 20, 21, 29 and 30 are inherently included in the process of loan data processing as discloses by McDonald since such processes as borrower’s authorization and consulting the borrower are customary in the art of loan processing.

Claim 19: borrowers’ authorization includes obtaining electronic signature..([0063], “.. authentication process for the client/user may include digital signature authentication as well as other types of cryptographic verification and authentication of users.”)

6. Claims 31-34 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6438526 (Dykes et al.). (Dykes).

As per claim 31 Dykes teaches all elements of the qualification processing apparatus including a comparison module, rate filter and a commission filter (see OBJECTS AND SUMMARY OF THE INVENTION and Figures 1 and 2c, 2f and 5, which show the commission filter as generating loan rate matrix detailing loan rates and commissions as points). Note that Dykes incorporates all functionality of the components of the apparatus recited in the subject claims.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 22-28 rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald.

Claim 22: McDonald, while teaches the step of returning list of qualified loan programs and respective loan information, ([0062] .. The borrower-supplied credit data is then passed to a Loan Origination & Program Matching module 407 (456 in FIG. 4C). The Loan Origination & Program Matching module returns a list of loan products for which the borrower is qualified 409), wherein loan information comprises term, points and associated interest rates based upon the borrower credit score, fails to explicitly teach that the list of qualified loan programs comprises commission rate.

However this differences is only found in the non-functional data of the list. The specific Data which the list is comprised of, and in particular the commission rate is not functionally

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related to the substrate of the article of manufacture or the underlying process. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). In other words, the process of method is carried out independent of what the list comprises. McDonald reference is capable of returning a list of qualified loan program with any pertinent loan information including the recited elements.

Claims 23-26 are similarly analyzed.

Claims 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald.

McDonald fails teach that the list of qualified loan programs includes a visual indicator for loan programs having certain attributes (commission below a minimum).

Official Notice is taken that providing a visual indicator for (an icon or graphical character etc.) to bring any other suitable characteristics of the list items to the user's attention is old and well known.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide a visual indicator as recited for obtain the stated benefit.

Claim 28 is also analyzed on similar grounds.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jagdish N. Patel

(Primary Examiner, AU 3624)

4/19/06